

REMARKS

The Amendments

Claim 1 is amended to incorporate the substance of claim 6 therein. Claims 6 and 7 are accordingly canceled and the claims non-elected pursuant to the restriction requirement are canceled. Claim 2 is amended to address the 35 U.S.C. §112 rejection, as discussed below. New dependent claims are added which are supported by the original claims and by the disclosure at page 8, lines 27-30, for example. New compound claims are added which are supported by the disclosure at page 5, lines 15-23, for example.

Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Restriction/Election of Species

Applicants have canceled the claims to the non-elected method without prejudice to filing a divisional application thereto.

Applicants have added new compound claims. Although the original filing did not contain compound claims, applicants urge that these claims be examined together with the elected method claims. In view of the narrow scope of the compounds defined, i.e., two specific formulae, search and examination of these compounds (which likely were already searched when searching the methods) is not believed to amount to an undue burden on the Examiner; see, e.g., M.P.E.P. §803.

Applicants understand that the election of species is not a restriction requirement. As stated in the Office action initially setting forth the election of species requirement, upon a finding of allowability of a generic claim, applicants will be entitled to examination on the additional species within this same application.

The Objection to the Specification

The Office action objects to the attempt to incorporate by reference to a website link. Applicants submit that there is no statement that such material is intended to be incorporated by reference into the application. Thus, there should be no objection.

The Rejection under 35 U.S.C. §112, first paragraph

The rejection under 35 U.S.C. §112, first paragraph, for lack of enablement is believed to be rendered moot by the above amendments. The “prophylaxis” term is removed from the claims. This should not be considered as an admission that the term “treating” would not generally include preventative treatments. The rejection should, therefore, be withdrawn.

The Rejection under 35 U.S.C. §103

The rejection of claims 1-3 under 35 U.S.C. §103 as being obvious over Prickaerts (Eur.J.Pharm.) in view of Andreevna (J.Neuroscience) and Phillips (U.S. Patent No. 6,100,037), is believed to be rendered moot by the above amendments. Claims 6 and 7 defining the compounds was indicated in the Office action to be free from the prior art. The substance of claim 6 is incorporated into the independent claims 1 and 20, upon which all other claims

ultimately depend. None of the cited references provide any disclosure of the compounds recited in the claims or similarly structured compounds. Thus, the rejection under 35 U.S.C. §103 should be withdrawn.

The Provisional Obviousness-type Double Patenting Rejections

The provisional rejections of claims 1-3 for obviousness-type double patenting over copending application Ser. Nos. 10/556,437; 10/556,224; and 10/525,115; are believed to be rendered moot also. As explained above, the substance of claim 6 specifying the compounds is incorporated into the instant claims. Claim 6 was not subject to this rejection and the claims of the copending applications do not literally encompass the instant claims reciting the compounds. Thus, these provisional rejections should be withdrawn.

The provisional rejection of claims 1-3 for obviousness-type double patenting over copending application Ser. No 10/524,956 is respectfully traversed. Overlap – but not identity – does remain between the instant claims and the currently pending claims of this application, i.e. the compounds in ‘956 generically encompass the compounds of the instant claims. However, in such a circumstance of provisional obviousness-type double patenting between two pending applications, the provisional rejection should be withdrawn in the earlier filed of the two applications. The current application is the earlier filed. The instant application was filed on October 14, 2005, as a national phase from a PCT filed August 11, 2003. The ‘956 application was filed on December 15, 2005, as a national phase from a PCT filed August 13, 2003. In accordance with M.P.E.P. §804(I)(B)(1), “If a “provisional” nonstatutory obviousness-type

double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.” Since it appears that all the other rejections are overcome, this provisional rejection should be withdrawn in accordance with the PTO practice.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/John A. Sopp/

John A. Sopp, Reg. No. 33,103
Attorney/Agent for Applicant(s)

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

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